

Remarks

Claim 13 is cancelled. Claims 1-12 and 14-16 are pending.

Objection based on 37 C.F.R. §1.75

Claims 11 is provisionally objected to under 37 C.F.R. §1.75 as being a duplicate of Claim 13. To facilitate prosecution on the merits, Claim 13 is canceled. Although the Office Action placed this objection under a heading labeled “Double Patenting”, Applicants do not see any Double Patenting objection referenced in the Office Action.

Rejection based on 35 U.S.C. §101

Claims 1-16 are rejected under 35 U.S.C. §101.

In rejecting claims 1-16 because the claimed invention is directed to non-statutory subject matter, the Examiner states:

“Claims 1-8 can reflect a series of mental/manual steps. The claimed invention simply manipulates abstract ideas without practical application in the technical arts. Consequently the claimed invention does not require the technical or useful arts and, thus, fails to define patentable subject matter.

Claims 9-15 recite non-functional descriptive material, specifically software on a computer readable medium not tangibly embodied to a computer. Consequently, the claimed invention does not require the technical or useful arts and, thus, fails to define patentable subject matter. The rejection to these claims may be overcome if an inference to some form of hardware is claimed.

Claim 16 is software per se and is not tangibly embodied to a computer system. Consequently, the claimed invention does not require the technical or useful arts and, thus, fails to define patentable subject matter. The rejection to these claims may be overcome if an inference to some form of hardware is claimed.”
Office Action, page 2-3.

However, as discussed below, the Federal Circuit has clearly ruled that the only relevant test here is simply whether the invention produces a useful, concrete and tangible result.

Any process, whether electronic, chemical, or mechanical in nature, necessarily involves an algorithm in the broad sense of the term. AT&T Corp. v. Excel Communications Inc., 50 U.S.P.Q. 2d 1447, 1450 (Fed. Cir. 1999), citing, State Street Bank & Trust Co. v. Signature Financial Group, 47 U.S.P.Q.2d 1596, 1602 (Fed. Cir. 1998). The proscription against patenting a “mathematical algorithm”, to the extent that it still exists, is narrowly limited to claims directed toward mathematical algorithms in the abstract. Id. A process that applies an equation to a new and useful end is not barred by 35 U.S.C. §101. AT&T, 50 U.S.P.Q. 2d at 1451, citing, Diamond v. Diehr, 450 U.S. 175, 188 (1981). An unpatentable mathematical algorithm can be identified in that it is merely an abstract idea constituting a disembodied concept and thus not useful. AT&T, 50 U.S.P.Q. 2d at 1451 citing, State Street Bank, 47 U.S.P.Q. 2d at 1601. Thus, a claimed process, as found in claims 1-8, satisfies the requirement of 35 U.S.C. §101 if it produces a useful, concrete and tangible result Id. (emphasis added).

“The subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena.” MPEP §2106. The test for statutory subject matter does not relate to whether steps can be practiced mentally or manually or whether the claims recite a machine or a computer – as is suggested by the Office Action in claims 1-8 and 9-15, respectively.

Process claims do not specific technology expressly recited to satisfy the requirements of 35 U.S.C. §101 – as is suggested in the Office Action. State Street Bank, 47 U.S.P.Q.2d at 1601. First, claims directed toward a process do not even necessitate such a structural inquiry. Id. Moreover, such a structural limitation requirement probably stems from the now defunct Freeman-Walter-Able test. Id. at 1453. This test, in light of recent court rulings, has little applicability as even if the “claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a ‘useful, concrete and tangible result.’” Id.

As to the Office Action’s suggestion that claim 16 is “software per se”, in AT&T, the relevant patent (U.S. Patent No. 5,333,184) dealt with facilitating billing techniques for long distance carriers. The patent disclosed adding a PIC (primary interexchange carrier) indicator

into a data field of a standard message record. Id. at 1448. A subscriber could be billed differently depending upon whether the subscriber called someone with the same or different long-distance carrier based on the PIC indicator. Id. at 1448-1449. The claim in question recited, in part,

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

AT&T, 50 U.S.P.Q.2d at 1149 (emphasis in original). The AT&T court stated that although the determination of the PIC indicator value was derived using a simple Boolean mathematical formula (i.e. p and q), the claim did not attempt to protect this Boolean principle nor attempt to forestall its use in other applications. Id. at 1452. As the PIC indicator represented information about a call recipient's PIC, it was a useful non-abstract result of the claimed process. Id. Thus, since the claim produced a useful, concrete and tangible result and did not preempt a mathematical principle, the claimed presented statutory subject matter. Id.

In State Street Bank, the disputed patent was U.S. Patent No. 5,193,056 which disclosed a "HUB AND SPOKE" investment structure where mutual funds would pool their assets into an investment portfolio organized as a partnership. State Street Bank, 47 U.S.P.Q. 2d at 1598. The disputed claim recited a data processing system comprising five different means for processing data regarding assets, income, daily net unrealized gain or loss, and year-end income for a portfolio and then allocating such data for each fund in the portfolio. Id. at 1599. The State Street Bank court held:

the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result" – a final share price momentarily fixed for recording or reporting purposes...

Id. at 1601. As the disputed claim in State Street Bank was directed to a machine which produced a useful, concrete tangible result, the claim represented statutory subject matter "even

if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.” *Id.* at 1602. These cases clearly show a process implemented through software are patentable. In addition, “if a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760.” M.P.E.P. § 2106.

Here, independent claims 1, 13 and 16 relate to methods for indexing data. One example of a useful, concrete and tangible result from such claims is of course, indexed data. Other results are possible as well. Clearly no mathematical algorithm or law of nature is going to be preempted by these claims. Moreover, while the invention could be implemented using a computer or other machine as suggested in the Office Action, such a requirement is not necessary. Therefore, reconsideration of the rejection of claims 1-16 under 35 U.S.C. §101 is respectfully requested.

Rejection based on 35 U.S.C. §103

Claims 1-16 are rejected under 35 U.S.C. §103(a) as being obvious in view of U.S. Patent 6,112,203 to Bharat et al. (“Bharat”). Reconsideration of the application in light of the remarks below is respectfully requested.

In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim limitations. M.P.E.P. §706.02(j). The Office Action has not met that burden here.

Among the limitations of independent claim 1, which are neither shown nor suggested in the art of record are:

A method for including a document in an index in a hyperlinked environment, comprising the acts of: ... retrieving anchor text associated with at least one of the hyperlinks; parsing the anchor text into one or more tokens; for each token: determining a weight for the token, determining whether the weight assigned to the token exceeds a threshold token weight; and indexing the document under the token

Among the limitations of independent claim 9, which are neither shown nor suggested in the art of record are:

A program product embedded in a machine-readable medium for including a document in an index in a hyperlinked environment, comprising the instructions for: ... retrieving anchor text associated with each hyperlink; parsing the anchor text into one or more tokens; and program instructions for each token comprising instructions for: determining a weight for the token, ... and indexing the document under the token

Among the limitations of independent claim 16, which are neither shown nor suggested in the art of record are:

A system for indexing a document in a hyperlinked environment, comprising: ... a module for retrieving anchor text associated with each hyperlink; a parsing module for parsing the anchor text into one or more tokens; a module for: determining a weight for the token, ... and indexing the document under the token

The Office Action, on page 4 indicates that Bharat discusses anchor text and points to Col. 3, lines 3-15, which recites “The score is a weighted sum of the number of directed edges to and from a node and the number of unique sub-strings of the URL that match a query term.” However, Bharat does not teach or make use of anchor text. The Examiner attempts to equate “unique sub-strings of the URL” with “Anchor text.” Anchor text is, for example, text associated with a URL, but not the URL itself. See, e.g., specification, page 2, lines 11-18. When a user clicks on Anchor text, the browser processes the associated URL. For example, a web page article describing United Airlines may have “United Airlines” as Anchor text, whereas the associated URL would be <http://www.UAL.com>. Bharat simply does not teach or suggest the use of Anchor text. Since Bharat does not teach nor suggest the use of anchor text, it also does not teach or suggest the limitation of parsing anchor text into one or more tokens. Therefore Bharat neither teaches nor suggests the above referenced limitations of independent claims 1, 9 or 16.

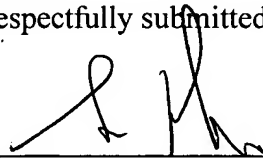
Additionally, the Office Action, also on page 4, admits that Bharat reference does not show “indexing,” but points to col. 4, lines 9-11 in Bharat as showing an index. Even if Bharat were said to show indexing, clearly there is no indexing under a token, as is claimed in independent claims 1, 9 and 16, since Bharat does not discuss tokens as claimed.

Therefore, it is asserted that independent claims 1, 9 and 16 are patentable over Bharat.

Dependent claims 2-8, 10-12 and 14-15 include the above referenced limitations of independent claims 1 and 9, respectively, and include additional recitations which, when combined with independent claims 1 and 9 are also neither disclosed nor suggested in the art of record. It is asserted that these claims are patentable as well.

Reconsideration of the rejection of claims 1-12 and 14-16 under 35 U.S.C. §103 is respectfully requested in light of the remarks above.

Respectfully submitted,



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